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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,754	02/23/2004	Rafi Rabipour	85773-447	6181
7590	09/04/2009		EXAMINER	
SMART & BIGGAR			GEORGALIS, NICHOLAS C	
Suite 3400				
1000 de la Gauchetiere Street West			ART UNIT	PAPER NUMBER
Montreal, QC H3B 4W5				4192
CANADA				
			MAIL DATE	DELIVERY MODE
			09/04/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/782,754	RABIPOUR ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	NICHOLAS C. GEORGALIS	4192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 23 February 2004.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-23 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-23 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 23 February 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date <u>10/14/2004</u> .	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-23 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. US 7203226 B1 Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims refer to encoders and decoders in a TFO (Tandem Free Operation) wherein it is obvious to one skilled in the art at the time of the invention to bypass intervening encoding by enabling means of detecting the type of terminating decoder and selecting the compatible decoder wherein the process of selection is equivalent to the process of bypassing. That is when one decoder is selected the others are naturally bypassed.

## 2. For Example

10/782754	Patent 7203226
Claim 1  first interface for exchanging data with a first neighboring entity; a second interface for exchanging data with a second neighboring entity; a memory for storing codec information regarding said communication apparatus; a control entity operative to detect a first message from the first neighboring entity via the first interface, the first message being indicative of codec information regarding an originating entity; responsive to detection of the first message, the control entity being operative to perform an assessment of compatibility between the codec information regarding the originating entity and the codec information regarding said communication apparatus; responsive to the assessment of compatibility being positive, the control entity being operative to self-identify the communication apparatus as a candidate for terminally supporting a subsequent codec-bypass negotiation with the originating entity; responsive to the assessment of compatibility being negative, the control entity being operative to self-identify the communication apparatus as a candidate for non-terminally supporting a subsequent codec-bypass negotiation with the originating entity	a) a communication interface for communicating with a first remote entity, the first remote entity including a decoder capable of decoding data encoded according to a first encoding format; b) a control entity operative to detect an attempt by a second remote entity to establish a TFO connection with said communication apparatus via said communication interface, for sending to the first remote entity, via said communication apparatus data encoded according to a second encoding format, different from the first encoding format, the decoder at the first remote entity being incompatible with data encoded according to the second encoding format, said control entity detecting an attempt by the second remote entity to establish a TFO connection by monitoring control messages sent by the second remote entity to said communication apparatus; c) in response to the detecting, said control entity enabling a converter to convert data encoded according to the second encoding format received from the second remote entity into data encoded according to the first encoded format, and sending the data encoded according to the first encoded format to the first remote entity via said communication interface.

3. Claims 1-23 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-20 of copending Application No. 11/984490. This is a

provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: Methods and apparatus for bypassing codecs in a tandem environment in order to improve signal fidelity.

For Example:

10/782754	Copending Application 11/984490
Claim 1	Claim 1
a first interface for exchanging data with a first neighboring entity; a second interface for exchanging data with a second neighboring entity; a memory for storing codec information regarding said communication apparatus; a control entity operative to detect a first message from the first neighboring entity via the first interface, the first message being indicative of codec information regarding an originating entity; responsive to detection of the first message, the control entity being operative to perform an assessment of compatibility between the codec information regarding the originating entity and the codec information regarding said communication apparatus; responsive to the assessment of compatibility being positive, the control entity being operative to self-identify the communication apparatus as a candidate for terminally supporting a subsequent codec-bypass negotiation with the originating entity; responsive to the assessment of compatibility being negative, the control entity being operative to self-identify the	an interface for enabling communication with a remote entity via a network; a control entity in communication with said interface and operative to: establish a packet-switched connection with the remote entity through the network; negotiate with the remote entity using <u>in-band signaling entry into a codec-bypass mode of operation.</u>

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<p>communication apparatus as a candidate for non-terminally supporting a subsequent codec-bypass negotiation with the originating entity.</p>	
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Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

4. Claims 1-23 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-42 of copending Application No. 10/682070. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

5. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: Methods and apparatus for bypassing codecs in a tandem environment in order to improve signal fidelity.

#### 6. For Example

10/782754	Copending Application 10/682070
Claim 1	Claim 1
a first interface for exchanging data with a first neighboring entity; a second interface for exchanging data with a second neighboring entity; a memory for storing codec information regarding said communication apparatus; a control entity operative to detect a first message from the first neighboring entity via the first	an interface for enabling communication with a remote entity via a network; a control entity in communication with said interface and operative to: establish a packet-switched connection with the remote entity through the network; negotiate with the remote entity using in-band signaling entry into a codec-bypass

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interface, the first message being indicative of codec information regarding an originating entity; responsive to detection of the first message, the control entity being operative to perform an assessment of compatibility between the codec information regarding the originating entity and the codec information regarding said communication apparatus; responsive to the assessment of compatibility being positive, the control entity being operative to self-identify the communication apparatus as a candidate for terminally supporting a subsequent codec-bypass negotiation with the originating entity; responsive to the assessment of compatibility being negative, the control entity being operative to self-identify the communication apparatus as a candidate for non-terminally supporting a subsequent codec-bypass negotiation with the originating entity.	mode of operation.
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7. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

8. Claims 1-23 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-42 of copending Application No. 10/235959. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

9. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that

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copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: Methods and apparatus for bypassing codecs in a tandem environment in order to improve signal fidelity.

10. For Example

10/782754	Copending Application 10/235959
Claim 1	Claim 4 and 6
a first interface for exchanging data with a first neighboring entity; a second interface for exchanging data with a second neighboring entity; a memory for storing codec information regarding said communication apparatus; a control entity operative to detect a first message from the first neighboring entity via the first interface, the first message being indicative of codec information regarding an originating entity; responsive to detection of the first message, the control entity being operative to perform an assessment of compatibility between the codec information regarding the originating entity and the codec information regarding said communication apparatus; responsive to the assessment of compatibility being positive, the control entity being operative to self-identify the communication apparatus as a candidate for terminally supporting a subsequent codec-bypass negotiation with the originating entity; responsive to the assessment of compatibility being negative, the control entity being operative to self-identify the communication apparatus as a candidate for non-terminally supporting a subsequent codec-bypass negotiation with the originating entity.	a codec for processing audio information exchanged with the remote entity over the first communication path.  wherein said control entity being operative to negotiate with the remote entity using in-band signaling includes said control entity being operative to: exchange in-band TFO messages with the remote entity over the first communication path; and determine <u>whether the connection can be transferred to the detected second communication path at least in part on the basis of the in-band TFO messages.</u>

11. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other

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copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Double Patenting***

***Statutory***

12. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

13. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

14. Applicant is advised that should claims 1-15 be found allowable, claims 18-21 and 22-23 will be objected to under 37 CFR 1.75 as being substantial duplicates thereof. When sets of claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one set of claims to object to the other set as being substantial duplicates of the allowed claims. See MPEP § 706.03(k)

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-23 rejected under 35 U.S.C. 102(b) as being anticipated by US 6185424 B1 Pon, Hermon et al. hereafter Pon and as evidenced by ETSI TS 128 062 V4.2.0 (2001-12); Digital cellular telecommunications system (Phase 2+) (GSM); Universal Mobile Telecommunications System (UMTS); Inband Tandem Free Operation (TFO) of Speech Codecs; Service Description; Stage 3 (3GPP TS 28.062 version 4.2.0 Release 4) hereafter ETSI TS 128 062 V4.2.0.

16. Regarding Claim 1 Pon column 2 lines 3-6 discloses “*...first interface for exchanging data with a first neighboring entity...*”; column 2 line 7-11 discloses “*...a second interface for exchanging data with a second neighboring entity...*” wherein “*...a memory for storing codec information regarding said communication apparatus...*” is inherent to the art as evidenced in ETSI TS 128 062 V4.2.0 wherein pg 142 speaks to a “Codec List” which must only exist in memory and for the purpose of selecting the codec corresponding to the signal encoding; Pon column 2 lines 16-27discloses “*...a control entity operative to detect a first message from the first neighboring entity via the first interface, the first message being indicative of codec information regarding an originating entity; responsive to detection of the first message, the control entity being operative to perform an assessment of compatibility between the codec information regarding the originating entity and the codec information regarding said communication apparatus...*” Pon column 2 lines 16-27discloses “*...responsive to the assessment of compatibility being positive, the control entity being operative to self-identify the*

*communication apparatus as a candidate for terminally supporting a subsequent codec-bypass negotiation with the originating entity; Pon column 2 lines 16-27discloses “...responsive to the assessment of compatibility being negative, the control entity being operative to self-identify the communication apparatus as a candidate for non-terminally supporting a subsequent codec-bypass negotiation with the originating entity...”*

17. Regarding Claim 2 Pon discloses all in Claim 1 in addition Pon column 4 lines 13-21 discloses *“... responsive to the assessment of compatibility being positive, the control entity being further operative to release a second message towards the first neighboring entity via the first interface, the second message being indicative of the communication apparatus being self-identified as a candidate for terminally supporting a subsequent codec-bypass negotiation with the originating entity...”* wherein the handshaking of Pon includes the second message of application.

18. Regarding Claim 3 Pon discloses all in Claim 1 in addition Pon column 5 lines 31-42 discloses *“...responsive to absence of any message from the second entity indicative of the second entity being self-identified as a candidate for terminally supporting a subsequent codec-bypass negotiation with the originating entity, effecting said subsequent codec-bypass negotiation with the first entity...”*

19. Regarding Claim 4 Pon discloses all in Claim 1 in addition Pon column 5 lines 43-49 discloses *“...the control entity being operative to forward the first message to the second remote entity via the second interface...”*

20. Regarding Claim 5 Pon discloses all in Claim 1 in addition *“...wherein the first and second interfaces are packet interfaces...”* is inherent to the art at the time of the

invention as evidenced by ETSI TS 128 062 V4.2 page 14 wherein packet switched transmission is addressed for the purpose of implementing an interface between circuit switched and packet switched networks.

21. Regarding Claim 6 Pon discloses all in Claim 1 in addition “*...the first interface is a packet interface and the second interface is a circuit-switched interface...*” is inherent to the art at the time of the invention as evidenced by ETSI TS 128 062 V4.2 page 141 wherein the Media Gate Way by definition connects disparate telecommunications networks such as the packet switch and circuit switch networks of application and as defined in the application specifications and for the purpose of implementing an interface between circuit switched and packet switched networks

22. Regarding Claim 7 Pon discloses all in Claim 1 in addition Pon Fig 1 shows and column 1 lines 40-46 disclose “*...the first and second interfaces are circuit-switched interfaces...*” wherein the PSTN is a circuit switched network and the interfaces are between two codecs.

23. Regarding Claim 8 Pon discloses all in Claim 1 in addition Pon column 2 lines 14- 27 discloses “*...detect a second message received from the second neighboring entity, the second message being indicative of the second neighbouring (sic) entity apparatus being self-identified as a candidate for terminally supporting a subsequent codec-bypass negotiation with the originating entity; responsive to detection of the second message, self-identify the communication apparatus as a candidate for non-terminally supporting a subsequent codec-bypass negotiation with the originating entity...*

24. Regarding Claim 9 Pon discloses all in Claim 8 in addition Pon column 2 lines 16-28 discloses “... *the control entity being operative to forward the second message to the first remote entity via the first interface....*”

25. Regarding Claim 10 Pon discloses all in Claim 8 in addition Pon column 4 lines 13-24 discloses “...*the control entity being further operative to monitor messages exchanged via the first and second interfaces that are indicative of negotiation of a codec-bypass connection between the originating entity and an entity different from the originating entity....*” wherein the handshake of Pon is equivalent to the negotiation of application.

26. Regarding Claim 11 Pon discloses all in Claim 10 in addition Pon column 5 lines 60-67 through column 6 lines 1-6 discloses “...*detect success or failure of said first negotiation; and responsive to failure of said first negotiation, and if the communication apparatus is self-identified as a candidate for terminally supporting a subsequent codec-bypass negotiation with the originating entity, negotiate with the originating entity a codec-bypass connection between the communication apparatus and the originating entity...*”

27. Regarding Claim 12 Pon discloses all in Claim 11 in addition Pon column 5 lines 60-67 through column 6 lines 1-6 discloses “...*responsive to success of said first negotiation, and if the communication apparatus is self-identified as a candidate or terminally supporting a subsequent codec-bypass negotiation with the originating entity, the control entity being operative to self-identify the communication as a candidate for non-terminally supporting a codec-bypass negotiation with the originating entity...*”

28. Regarding Claim 13 Pon discloses all in Claim 10 in addition Pon column 5 lines 60-67 through column 6 lines 1-6 discloses “*...detect success or failure of said first negotiation; and responsive to success of said first negotiation, and if the communication apparatus is self-identified as a candidate or terminally supporting a subsequent codec-bypass negotiation with the originating entity, the control entity being operative to self-identify the communication as a candidate for non-terminally supporting a codec-bypass negotiation with the originating entity...*”

29. Regarding Claim 14 Pon discloses all in Claim 11 in addition “*...wherein the originating entity is an endpoint gateway...*” is inherent to the art at the time of the invention as evidenced by ETSI TS 128 062 V4.2 page 141 wherein the Media Gate Way by definition connects disparate telecommunications networks such as the packet switch and circuit switch networks of application and as defined in the application specifications and is essential to the enablement of the invention.

30. Regarding Claim 15 Pon discloses all in claim 11 in addition “*...the originating entity is an in-path gateway...*” is inherent to the art at time of the invention as evidenced by ETSI TS 128 062 V4.2 page 15 wherein the Tandem Free Operation is activated and controlled by the Transcoder Units which are equivalent to the in-path gateway of application. Said gateways performing the decoder selection function of the transcoder units and essential to the enablement of the invention.

31. Claim 16 is a methods claim reciting apparatus claims 1-15 and therefore an inherent variation thereof and interpreted by Examiner accordingly. Therefore Claim 16 is rejected for the same reason.

32. Claim 17 is an apparatus claim reciting the apparatus claims 1-15 and an inherent variation thereof and interpreted by Examiner accordingly. Therefore Claim 17 is rejected for the same reason.

33. Claims 18-21 and 22-23 are methods claims which read upon Claims 1-15 and are substantial duplicates thereof and interpreted by Examiner accordingly. Therefore Claims 18-21 and 22-23 are rejected for the same reasons.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 4455649 A                  Esteban; Daniel J. et al.

US 6006189 A                  Strawczynski; Leo et al.

US 6295302 B1                Hellwig; Karl et al.

US 6298055 B1                Wildfeuer; Herbert M.

US 20020019881 A1            Bokhari, Wasiq M. et al.

US 20020049860 A1           Koistinen, Tommi

US 20020118673 A1           Abrishami, Mehrdad et al..

All speak to bypassing codecs in a communication system under predetermined conditions for the purpose of increasing fidelity of the signal.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICHOLAS C. GEORGALIS whose telephone number is (571)270-3727. The examiner can normally be reached on Monday through Thursday 8:00-7:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Harold can be reached on (571)272-7519. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. C. G./  
Examiner, Art Unit 4192  
/George Nguyen/  
Supervisory Patent Examiner, Art Unit 4134